



09-20-02

DAE

#9

PATENT
ATTORNEY DOCKET NO. 11325-84822

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Rafael A. Sierra et al.) Examiner:
)
Serial No.: 09/924,156) Art Unit: 3739
)
Filed: August 7, 2001)
)
Title: METHOD FOR TREATING ACNE)

RECEIVED
SEP 23 2002

OFFICE OF PETITIONS

Assistant Commissioner for Patents
Attn: Office of Petitions
Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

RENEWED PETITION TO BEGIN PROSECUTION UNDER 37 CFR 1.47(a)
WITHOUT THE SIGNATURE OF INVENTOR KATHLEEN MCMILLAN

Dear Sir:

This is filed in response to the Decision Dismissing Petition mailed July 23, 2002 from the Office of Petitions. The Office of Petitions dismissed applicants' petition as lacking evidence that the entire application including the specification, claims and drawings were sent to Kathleen McMillan for review.

Applicants hereby respectfully renew their petition to the Commissioner under 37 CFR 1.47(a) to begin prosecution of the above-referenced patent application without the declaration signature of inventor Kathleen McMillan. In support of the present petition, Applicants are filing herewith in response to the Decision Dismissing Petition.

1. The Declaration of Dona-Maria Dean which provides the required factual proof that an entire copy of the application including the specification, claims and drawings were sent to Kathleen McMillan, along with the inventor declaration for signature.

2. The Declaration of Rafael A. Sierra (re-executed) which provides the required factual proof that Ms. McMillan was provided a copy of the application, including the specification, claims and drawings, and the declaration for signature and that she has refused to execute the declaration and

3. the last known address of Kathleen McMillan which is 1958 Main Street, Concord, MA 01742.

Pursuant to 35 USC 116, if a joint inventor refuses to join in an application for patent, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined.

Pursuant to 37 CFR 1.47, if a joint inventor refuses to join in an application for patent, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including statement of the pertinent facts, the fee set forth in section 1.17(h), and the last known address of the nonsigning inventor. Pursuant to MPEP 409.03(a), an oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s) pursuant to 37 CFR 1.64.

The Declaration of Dona-Maria Dean states that on November 30, 2001, an entire copy of the application including the specification, claims and drawings were sent to Kathleen McMillan, along with the inventor declaration for signature. The Declaration clarifies the confusing cover letter that was sent with the application including the specification, claims and drawings.

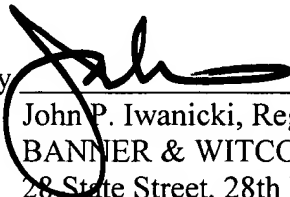
The Declaration of Rafael A. Sierra states that on November 30, 2001, a copy of the application, including the specification, claims and drawings, the assignment to the New England Medical Center Hospitals, Inc. and the inventor declaration was sent by first class mail to the home of Kathleen I. McMillan at 1958 Main Street, Concord, MA 01742. On March 7, 2002, Rafael A. Sierra called Kathleen McMillan at her place of employment Candela Corporation, 530 Boston Post Road, Wayland, MA 01778. Rafael A. Sierra confirmed that Kathleen McMillan received the application, including the specification, claims and drawings, and the inventor declaration and Rafael A. Sierra asked that Kathleen McMillan execute the inventor declaration. Kathleen McMillan told Rafael A. Sierra that she would not execute the inventor declaration. Kathleen McMillan stated as the basis for her refusal to sign that she thought the application would not be in the best interests of her present employer.

Applicants respectfully submit that they have met the requirements of 37 CFR 1.47(a) to begin prosecution on the merits without the declaration signature of Kathleen McMillan. Applicants, therefore, respectfully request that the Commissioner grant the present renewed petition.

No fees are believed due. However, the Commissioner is hereby authorized to charge any additional fees to Deposit Account No. 19-0733.

Respectfully submitted,

Dated: September 19, 2002

By 
John P. Iwanicki, Reg. No. 34,628
BANNER & WITCOFF, LTD.
28 State Street, 28th Floor
Boston, MA 02109
(617) 227-7111